LIBRARY
SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
JUL 19 1968
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

October Term, 1968

No. 315

MASON HOFFENBERG,

Petitioner,

v.

ABRAHAM L. KAMINSTEIN, REGISTER OF COPYRIGHTS,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

CHARLES REMBAR,
MORTON M. YOHALEM,
Attorneys for Petitioner,
19 West 44th Street,
New York, N. Y. 10036.

INDEX

	PAGE
Opinion below	1
Jurisdiction	1
Questions presented	2
Statutes involved	3
Statement	3
Reasons for granting the writ	5
Conclusion	30
Appendix A—Statutes	A-1
B—Opinion and judgment below	A-6

Citations

CASES:

Bailie v. *Fisher*, 258 F.2d 425 (D.C. Cir.)	28
Bolling v. *Sharpe*, 347 U.S. 497	27
Brown Instrument Co. v. *Warner*, 161 F.2d 910 (D.C. Cir.)	28
Dombrowski v. *Pfister*, 380 U.S. 479	27
Ferris v. *Frohman*, 223 U.S. 422	30
Flora v. *United States*, 362 U.S. 145	23
Grove Press v. *Christenberry*, 275 F.2d 433 (2 Cir.)	25
Heim v. *Universal Pictures Co.*, 154 F.2d 480 (2 Cir.)	22
King Features Syndicate v. *Bouve*, 48 U.S.P.Q. 237 (D.C.D.C.)	28

PAGE

CASES (Cont'd):

Mazer v. *Stein*, 347 U.S. 201 25

Memoirs v. *Massachusetts*, 383 U. S. 413 27

Schneider v. *Rusk*, 377 U.S. 163 27

20th Century Fox Film Corp. v. *Bouve*, 33 F. Supp. 462 (D.C. D.C., aff'd., 122 F.2d 51 (D.C. Cir.) .. 28

United Dictionary Co. v. *Merriam Co.*, 208 U. S. 260 .....2, 15, 24

United States ex rel. Everson v. *Young*, 26 Wash. L. Rep. 546 (S. Ct. D.C.) 28

United States v. *Philadelphia National Bank*, 374 U. S. 321 23

United States v. *Price*, 361 U. S. 304 ..... 23, 24

United States v. *Wise*, 370 U. S. 405 ..... 23, 24

United States v. *Zachs*, 375 U. S. 59 23

Washingtonian Publishing Co. v. *Pearson*, 306 U. S. 30 .....12, 22, 25

Waterman Steamship Corp. v. *United States*, 381 U.S. 252 23

STATUTES:

UNITED STATES COPYRIGHT LAW, Act of March 4, 1909, c. 320, 35 Stat. 1075, et seq., as incorporated in the Act of July 30, 1947, c. 391, 61 Stat. 652, et seq., Title 17, U.S.C.:

Section 9 27

Section 10 .....3, 4, 5, 10, 11, 13, 22, 23, 29, 30

Section 13 .....3, 4, 6, 11, 17

PAGE

Section 16 .....3, 6, 7, 9, 10, 13, 14, 15, 17, 18, 22, 23

Section 22 .....3, 4, 5, 6, 7, 9, 10, 11, 13, 18, 22, 23

Section 23 .....3, 4, 6, 9, 10, 13, 22

Section 107 ..... 18, 26

Section 207 28

Act of 1891, 26 Stat. 1107 16

Act of 1904, 33 Stat. 4 18

Act of 1905, 33 Stat. 1000 18

Act of 1914, 38 Stat. 311 13

MISCELLANEOUS:

Regulations of the Copyright Office, 37 C.F.R. § 202.4(b)(1) (1956) 4

Hearings Before Committee on Patents, 49th Cong., 1st Sess. (1886) 19

S. Rept. No. 1188, 49th Cong., 1st Sess. (1886) ... 19

H. Rept. No. 7083, 59th Cong. 2d Sess. (1907) ... 12

S. Rept. No. 6187, 59th Cong. 2d Sess. (1907) ... 12

H. Rept. No. 2222, 60th Cong. 2d Sess. (1909) 18, 28

S. Rept. No 1108, 60th Cong. 2d Sess. (1909) 12

S. Rept. No. 375, 81st Cong., 1st Sess. (1949).... 20

H. Rept. No. 83, 90th Cong. 1st Sess. (1967) 20

Congressional Record 2604, 2605 (1891) 19, 20

Davis, *Administrative Law Treatise* 25

Howell, *The Copyright Law, Third Ed.* (1952)... 25

Latman, *Howell's Copyright Law* (1962) 11

The *New York Times*, May 26, 1968, p. 15 ..... 8, 9

IN THE

Supreme Court of the United States

October Term, 1968

No.

MASON HOFFENBERG,

Petitioner,

v.

ABRAHAM L. KAMINSTEIN, REGISTER OF COPYRIGHTS,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia Circuit, entered in the above-entitled case on April 23, 1968.

Citations to Opinions Below

There was no opinion in the District Court. The opinion of the Court of Appeals, printed in Appendix B hereto, is not yet reported officially but has appeared at 157 U.S.P.Q. 358.

Jurisdiction

The judgment of the Court of Appeals was entered on April 23, 1968. The jurisdiction of this Court is invoked under 28 U.S.C. Section 1254(1).

Questions Presented *

1. Under § 10 of the Copyright Act, must the publication with notice that secures copyright take place within the United States? (The Office contends that it must.)

2. Are the procedures described in § 22 and § 23 a mandatory and exclusive method of obtaining copyright in the circumstances mentioned in § 22 (as the Office contends) or do they provide a method alternative to that provided in § 10 (as the author contends)?

3. Do the provisions of § 16 apply without regard to whether the books are to be offered for sale in the United States or abroad (as the Office contends) or are they concerned only with the preservation of the United States market for United States manufacturers (as the author contends)?

4. Do the provisions of § 16 apply only to the manufacture of those copies that constitute the first publication of the work in question? (An affirmative answer is necessary to the Office position.)

5. If copyright was not secured by publication with notice abroad in 1958, was it nevertheless not lost (the principle of *United Dictionary Co.* v. *Merriam Co.*, 208 U. S. 260, controlling) so that copyright was secured by the 1964 publication in the United States?

6. Is Copyright Office Regulation § 202.4(b)(1) (which embodies the Office contentions referred to in the preceding questions) valid under the Act, and, if so, are §§ 16, 22 and 23, as thus construed and applied by the Office, unconstitutional under Article I, § 8, Clause 8 and Amendments I and V of the United States Constitution?

---

* The petitioner will be referred to as "the author" and the respondent as "the Copyright Office" or "the Office".

7. Apart from what may be the proper ultimate disposition of the author's claims against alleged infringers, does the Office have discretion to deny registration of a claim to copyright on the basis of its own view of a fundamental question of law where the result of the Office action is to subject the claimant's substantive rights to the risk of obliteration—by operation of the statute of limitations—prior to a judicial determination of the existence or nonexistence of those rights?

Statutes Involved

The statutory provisions involved are §§ 10, 13, 16, 22 and 23 of the Copyright Act, 17 U.S.C. § 1 *et seq.*, Act of March 4, 1909, c. 320, 35 Stat. 1075, *et seq.*, as incorporated in the Act of July 30, 1947, c. 391, 61 Stat. 652, *et seq.* They are printed in Appendix A *infra.** Appendix A also contains the Copyright Office Regulation referred to (37 C. F. R., § 202.4(b)(1).

Statement

Petitioner is one of the two American authors of a novel written in English and first published in France in 1958 (JA 38).** Each copy of the work published abroad bears a copyright notice as required by the Act (JA 39). Each copy of the work published abroad was manufactured

---

* The Copyright Act (17 U.S.C., § 1 *et seq.*) will hereinafter be referred to as "the Act" and its sections will be referred to hereinafter simply as "§ 10", § 13", etc. The addition of § 6 of the Act in 1947 (61 Stat. 654) raised the numbers of sections following it, so that the section presently designated § 10, for example, was § 9 of the Copyright Act of 1909, and similarly, § 22 was § 21. For convenience, the current numbering will be employed.

** The Joint Appendix filed in the court below has been designated as one of the items in the transcript of record for use on this petition, and references below designated "JA" are to that Appendix.

abroad (JA 38). No copy manufactured abroad was offered for sale in the United States by the authors or by anyone acting on their authority (JA 47). During the six-month period following first publication of the work abroad no steps were taken to effect compliance with § 22 (JA 38).

In May, 1964, G. P. Putnam's Sons published an edition of the work in the United States (JA 39). This has been the only publication of the work in the United States authorized by the authors (JA 47). All copies of the Putnam edition bear a copyright notice as required by the Act (JA 39). All copies of the Putnam edition have been manufactured in the United States (JA 47).

On March 11, 1965, the author, in accordance with § 13, mailed to the Copyright Office two copies of the American edition and an application for registration of a claim to copyright in the work under the provisions of § 10 (JA 7). The Office refused to register the claim to copyright on the ground that in its view copyright did not exist. By letter dated March 31, 1965 the Office cited Copyright Office regulation § 202.4(b), 37 C. F. R., as justification for its view, and took the position that in the circumstances copyright could be obtained only under the "ad interim" provisions, §§ 22 and 23 of the Act (JA 19). Section 202.4(b) has been in existence only since 1956, the Copyright Office prior to that time having taken the position that in circumstances like the present it would register the work. (The pertinent statutory provisions have not changed since 1909.)

In January, 1965, some eight months after the Putnam edition came out, infringing editions began to appear, and an action for copyright infringement was instituted by the authors and Putnam in the Southern District of New York (JA 48). In July, 1965 the action was dismissed without prejudice, on the ground that § 13 forbade the

maintenance of an action where a certificate of registration had not been issued (JA 48).

In May 1965 the author commenced this action for a judgment declaring that copyright had been secured in the work under the provisions of § 10 and directing the Copyright Office to accept copies of the work for deposit and to issue a certificate of registration in connection therewith (JA 1-6).* Cross-motions for summary judgment were made on the pleadings and on a stipulation of facts (JA 38-43). The District Court, without opinion, ordered that the author's motion be denied and the Office's motion be granted and that the action be dismissed. The Court of Appeals affirmed the orders, two judges joining in a *per curiam* opinion which relied upon the regulation and the third concurring without opinion.

Reasons for Granting the Writ

The Significance of the Case

The decision sought to be reviewed is a ruling upon an important question of federal law which has not been, but should be, decided by this Court. It is a question vexing to writers and publishers and much debated by practitioners and commentators, but, prior to this case, almost totally unexplored by the courts. It involves the meaning of § 10

---

* The author had, alternatively, sought registration under § 22, despite the fact that no application therefor had been made within the period provided in that section. The author's contention was that the six-month period should be deemed to have been tolled. He based this on a letter from a Customs official stating that during the prescribed period (six months following the 1958 publication) the book would not have been admitted into the United States, so that the necessary deposit in the Copyright Office could not have been made. After the institution of the present action, the government made representations to the effect that a book addressed to the Office would have been forwarded by Customs, despite any ban that may have existed against general importation, and the author accordingly withdrew this additional claim.

of the Act (the basic copyright-securing provision) and its interrelations with § 13 (the registration provision), § 16 (the "manufacturing clause") and §§ 22 and 23 (the "ad interim" procedures). Clarification and resolution will be helpful to writers generally, to publishers (both authorized and unauthorized), and ultimately to the readers and (consequently) to the general public.

Even in the present case, judicial expression on the matter has been meager. The District Court wrote no opinion. In the Court of Appeals one judge concurred without opinion, and the laconic *per curiam* opinion says nothing about the fundamental problems of copyright law that the case presents. The decision rests entirely on the Copyright Office regulation. The regulation is itself merely a statement of the Office interpretation of the statute. The opinion does not examine the validity of that interpretation, and, we respectfully submit, cannot amount to more than the announcement of a conclusion. (It does, however, note the Office concession that the regulation is, at least in some of its applications, invalid.) This decision can hardly be expected to settle the matter for other Circuits.*

The petitioner is not alone in the specific situation in which he finds himself. Our anti-obscenity laws, before the First Amendment was held to limit their operation, compelled a number of gifted American authors to find publishers abroad. The work at bar has itself received serious and favorable critical attention.** There is much other

---

* In the District Court, three extensive briefs were presented by each side, and in the Court of Appeals the author's main brief ran fifty-eight pages while the Office's ran sixty-six (excluding appendices). The length of the briefs—on both sides—was occasioned not by a failure to compress but by the complexity of the matter.

** See, e.g., *New York Sunday Times Book Review*, May 17, 1964; *Book Week*, May 17, 1964; *Life*, May 8, 1964; *Chicago Sun Times*, May 17, 1964; *Cleveland Plain Dealer*, June 14, 1964; *Newsweek*, December 21, 1964; *Boston Herald*, May 12, 1964.

writing, however, first published in similar circumstances, about whose importance there is broader consensus—the works of Henry Miller, Vladimir Nabokov, and J. P. Donleavy, for example.

Other situations involving the questions presented by this case keep coming up. American authors often have their works first published abroad in periodicals. This is typically writing of unquestioned political or scientific or literary value, but of doubtful commercial value. If the Office view is sustained, the author of such material is forced, on pain of losing his rights, to find a publisher who will undertake American manufacture and republication of his story, essay or poem, and within the limited period provided by the ad interim provisions—in most cases a hopeless undertaking. American photographers whose photographs and illustrators whose illustrations are offered first publication in other countries face the same dilemma.

Another group to whom the resolution of the issues presented by this case will be critical consists of distinguished European writers, now citizens of this country, who have continued to write in their native tongues. While § 22 refers only to works first published abroad in English, § 16, as interpreted by the Office, would also effect the forfeiture of works written in foreign languages unless the author first publishes an edition in the United States.* Even where such a work is translated into English, translations take time and are ordinarily not available until long after the original work is completed. The normal process would be to publish the work first in the country in whose language it is written, and then to publish a translated

* Section 16 contains an exception for works "of foreign origin in a language or languages other than English." The phrase "foreign origin" has been held to relate only to works by aliens, and the writers referred to here are American citizens.

version in the United States. The Office position makes this impossible; the author must either delay the publication of the original work until there is a translation and the translation can be given prior publication, or he must undergo the wasteful process of publishing a foreign-language token edition in the United States. And if his work does not have enough commercial value to warrant a token edition or translation-in-advance, the author is disabled from publishing his work among people likely to read it unless he is ready to sacrifice his copyright.

None of these classes of authors can find hope in the prospects (such as they may be) of new copyright legislation.* If anything, such legislation would magnify their loss—assuming the contentions made by the Office and sanctioned by the holdings below are correct—since the one change that seems to have drawn sufficient support for passage is an extension of the copyright term.** Such an enlargement of rights would apply only to subsisting copyrights. The works already shorn of protection (as the Office contention requires in the situations mentioned) could not benefit from the new legislation. And in any event, a new copyright act lies somewhere in the doubtful future.

Finally, unless the fact of "first manufacture" is given the vast and magic potency with which the Office—but not the language of the statute or its history—would endow it, the position taken by the Office in this case would forfeit copyright in all the greatest American literature of the

---

* The *New York Times* for May 26, 1968, p. 15, under the heading "Copyright Law Revisions Are Put Off" reported:

> "A bill to modernize the nation's copyright laws was killed for this session of Congress this week, despite an intensive effort by the copyright office to save some of its noncontroversial aspects."

** Witness Congress's year-to-year prolongation of renewal terms about to expire in anticipation of such an amendment.

twentieth century. The Office does not carry its argument to this logical conclusion, but while it thus seeks to avoid an unthinkable result, the avoidance throws the statute itself into a state of insupportable illogic.

It is widely recognized that the manufacturing clause needs elucidation. The public importance of the provision and the turmoil it creates was recently emphasized by the Register of Copyrights himself. The newspaper report mentioned above contained, under the subhead "Two Changes Sought", the following:

> "Senator McClellan offered his substitute bill in spite of an appeal by Abraham L. Kaminstein, head of the Copyright Office, to include in the stopgap measure at least two changes that have won general acceptance. They are the extension of copyright protection for an author for life plus 50 years, instead of the present maximum span of 56 years, and relaxation of a *requirement that a book must be printed in this country to qualify for United States copyright protection.*
>
> "Mr. Kaminstein said he considered the adoption of these measures to be essential to help American authors and to restore confidence abroad in United States adherence to modern international standards." (New York Times, May 26, 1958, p. 15. Emphasis supplied.)

While new legislation might well be helpful, we submit that the existing Act is, in this respect, not as bad as the Copyright Office suggests. The statute does not require the unfortunate result for which the Office contends in the present case. The difficulty stems rather from the fact that, since 1956, the Office has advanced a mistaken construction of §§ 22 and 23 and (ultimately) of § 16, and has sought to codify that construction by making a regulation of it—a regulation which in the course of this litigation has been conceded to be (at least in certain areas) incompatible with the statute.

The Provisions of the Statute and the Opposing Interpretations

The author, having published his work with the notice required by the statute, claims copyright under § 10. The Office, applying its regulation and making the judgment that the author has no copyright (a judgment the statute appears to reserve, in the first instance as well as on review, to the courts) refuses to register his claim. The reason given is that, since first publication of the work took place abroad and the authors are American citizens, §§ 22 and 23 impose a mandatory and exclusive method of securing copyright. The Office takes this position despite the fact that under the plain language of § 10 the author appears to have secured copyright, and despite the fact that §§ 22 and 23 neither purport to override § 10 nor contain any language suggesting they provide anything other than an alternate route to copyright. The Office, however, finds in the provisions of § 16 implicit warrant for expanding the meaning of §§ 22 and 23 and reading a qualification into § 10.

Section 10 in its entirety is as follows:

> "§ 10. PUBLICATION OF WORK WITH NOTICE.—Any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this title; and such notice shall be affixed to each copy thereof published or offered for sale in the United States by authority of the copyright proprietor, except in the case of books seeking ad interim protection under section 22 of this title."

The semi-colon breaks the section neatly in half. The first half has to do with securing copyright; the second half sets up a condition that must be met if the copyright secured is to be preserved. The first half of § 10 is unrestricted in its application; the second refers only to the United States. The explicit limitation in the second of the two cleanly separated parts of the section makes it impossible to read an implicit limitation into the first.

Section 10, which embodied a new approach to copyright, is the keystone provision in the Act. It is also an extraordinarily clear provision, one of the few precisely drafted sections in a statute noted for its ambiguities. And there is specific legislative history to show that its structure was deliberate and not fortuitous. When the bill which became the Act of 1909 was being considered, an earlier draft of § 10 provided that "any person entitled thereto by this Act may secure copyright for his work by publication thereof *in the United States* with notice of copyright required by this act." (Latman, *Howell's Copyright Law* (1962) p. 86. Emphasis supplied.) Congress changed this, and transferred the phrase "in the United States" to the second part of § 10. Thus, as originally drawn, the statute would have required that, in order to secure copyright, first publication (with notice) must take place in the United States, and the Office regulation would have been an accurate reflection of the statute. But before the bill became law, the requirement that the copyright-securing publication occur in the United States was deliberately rejected. There is nothing in § 10 as enacted that distinguishes between first publication in the United States and first publication abroad.*

The author has met the requirements of § 10. He has published his work with notice, thus establishing copyright under the first half of the section. Each copy of his work published or offered for sale in the United States by his authority has also contained the notice, so that the condition for preserving copyright has been fulfilled.

---

* The "except" clause at the end of the section was at first relied on by the Office in its refusal to register the author's claim of copyright. The Office contended that the clause showed that § 22 constitutes a qualification of § 10 and that § 10 therefore does not operate in the situations described by § 22 (Office letter of March 31, 1965, ninth paragraph, J.A. 22.) The Office later abandoned this contention, conceding that the "except" clause belongs to the second half of § 10 and modifies only the portion of the section that follows the semi-colon.

The Act of 1909 (35 Stat. 1075), which with minor amendments constitutes our present copyright law, marked a fundamental departure from the prior statutory system. From the beginning until 1909, copyright was obtained by deposit and registration at or about the time of first publication; putting notice of copyright in the book was merely a precondition to suit for infringement (1 Stat. 124; 2 Stat. 171; 4 Stat. 436; 16 Stat. 212). (In the various acts, including the present one, Congress has chosen to distinguish between right and remedy.) For the first 119 years of our copyright history, copyright was achieved by going through a prescribed procedure involving the government. But for the past sixty years, a radically different method has been in force. The author no longer "takes out copyright" by engaging in certain actions with respect to an agency of the government. Instead, he gets it on his own, by actions that take place entirely apart from the government; he gets it by the simple act of publication with notice.

Thus in 1909 notice and registration switched roles: publication with notice became the key to copyright, while registration, under § 13, became the precondition to suit. Congress was quite conscious of the change it was making: S. Rept. No. 6187, 59th Cong. 2d Sess. (1907) p. 5; H. Rept. No. 7083, 59th Cong. 2d Sess. (1907) p. 8; S. Rept. No. 1108, 60th Cong. 2d Sess. (1909) p. 10. This Court emphasized the difference between the new system and the old in *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30.

Section 13 contains the requirements for deposit and registration. Everything that happens under § 13, as its opening language states, takes place "After copyright has been secured by publication of the work with the notice of copyright as provided in section 10. . . ." The events that § 13 contemplates presuppose that copyright has been secured, and secured under § 10. The 1909 legislation as originally drafted (S. 6330; H. R. 19853 (1906)) did not

contain the quoted language; its later inclusion underscores its importance.*

Sections 22 and 23 in themselves contribute nothing to the solution of the questions this case involves. Nothing in these sections suggests that the procedure they provide is exclusive and mandatory, rather than an alternative (with certain advantages and disadvantages) that may be availed of. Nor is there anything in them to indicate an intent to modify the strong language of § 10. The Office, however, argues that § 16 prevents the author from securing copyright under § 10, and this being so, that §§ 22 and 23 provide the only possibility of achieving copyright. Thus the problem of statutory construction—affecting all six sections of the Act—turns on the meaning of § 10 and § 16.

Section 16 cannot operate if its terms are taken literally. On this petitioner and respondent agree.

If the terms of the section are taken literally, all the important American writing of the past half century would be without copyright protection. Neither the Office nor the author proposes such an interpretation. However, the interpretation relied on by the author, we submit, comports with general rules of construction, does no violence to the

---

* A 1914 amendment to § 13 (38 Stat. 311) supplies further confirmation of the fact that § 10 grants copyright without regard to where the publication takes place. Referring to the requirement in § 13 that two copies of a work must be deposited, the amendment added the following:

> ". . . or if the work is by an author who is a citizen or subject of a foreign state or nation, and has been published in a foreign country, one complete copy. . . ."

Keeping in mind that the amendment did nothing except to reduce the number of copies that the foreigner need deposit, it is seen that publication abroad, with notice, is within the contemplation of § 10. The fact that the amendment refers to an alien does not alter the situation; if § 10 applied only to publication within the United States, this 1914 legislation would have no meaning.

language of the section, and conforms to an explicit Congressional policy. The interpretation offered by the Office, on the other hand, requires the reading into the section of what amounts to an amendment of its terms, and negates both the Congressional policy referred to (which will be documented below) and the general principle that statutory language is not to be bent to the purposes of pirates.

The author reads § 16 as concerned with the American market—a reading consonant with the protectionist purpose of the manufacturing clause. The Office reads § 16 as concerned only with first publication, not with subsequent publication—a reading consonant not with any Congressional policy but only with a prior statutory mechanism that was superseded in 1909.

Ignoring its explicit exceptions (which do not apply to the issues of principal concern), § 16 requires that "the text of all copies accorded protection under this title" be printed and bound in the United States. An unqualified reading of § 16 would lead to the conclusion that if any copy of a work were manufactured aboard, that copy could not be protected by copyright. It would follow that anyone could make further copies from that copy—that is, bring out his own edition of the work—without paying royalties to its writer, no matter how punctilious the writer's compliance with other requirements of the Act. The result would be that every outstanding American literary work of the twentieth-century would have lost protection early in its copyright period. This is because all these works have been published in Great Britain, and the British editions have been manufactured by British printers and binders. The pirate would have only to use a copy of the British edition as the basis for his piracy.

It thus appears that § 16 cannot be given the shotgun construction that its words might suggest. No one—not the boldest pirate—has sought, without authority from the

copyright proprietor, to publish the works of Dreiser, Faulkner, Hemingway, Lewis, *et al.*, on the theory that the printing of a work outside the United States—a literal negation of the naked terms of § 16—in itself forfeits United States copyright protection.

Section 16 could hardly have been intended to have such an effect. And in fact it was not. The well-established canon of construction that a statute is not to be given extra-territorial application unless the legislative purpose to do so is clear (*United Dictionary Co.* v. *Merriam Co.*, 208 U.S. 260 and cases there cited) suggests that the requirement of domestic manufacture is not meant to extend to events that have no contact with the United States—the foreign manufacture of books for foreign markets. But it is not necessary to rely on abstract canon. There is in the history of the statute conclusive evidence that Congress enacted the manufacturing clause as a means of encapsulating the American market, and had no concern with the manufacture of books that would not be fed into the domestic economy. Section 16 is a protectionist provision, designed to preserve the American market for American printers and binders. (See Congressional documents cited below at pages 18-20).

The Office puts a different gloss upon § 16. It rejects any distinction based on the stated Congressional concern, and instead offers one based on time of manufacture. The requirements of the section, the Office contends, apply only to the first manufacture of a work, and not—though the statute makes no mention of any such exemption—to subsequent printings. Hence, says the Office, this author must lose his copyright because the first edition of his work was printed abroad, while those authors are safe who have editions printed abroad other than the very first. This distinction is not supported by any language contained in § 16 or in any other provision of the Act, nor by any social or economic goal that can be discerned in the Act itself or in extrinsic evidence of Congressional intent. It represents

a confusion of the pre-1909 copyright law with the present law, a confusion planted by early treatise-writers and allowed to take hold in absence of judicial treatment of the subject. It was occasioned by the fact that the first manufacturing clause came into the law in 1891, under the altogether different mechanism for obtaining copyright that existed prior to 1909. The Office position is imported from a statutory system deliberately abandoned by Congress.

The Genesis of the Manufacturing Clause.

In 1891 the benefit of United States copyright was for the first time extended to aliens. This was not a matter of generosity; Congress wanted to protect American authors whose works were published in Great Britain, and to accomplish this it was necessary to grant reciprocal rights to British authors. However, there had been a thriving business in this country built upon the royalty-free publication of British works, and Congress felt obliged to compensate American printers for the loss of this business. At the same time, Congress wanted to protect American printers from having their market diluted by books printed aboard. To attain these objectives, Congress did two things: (1) it forbade the importation of foreign-manufactured books; and (2) by making a slight but effective change in the then-existing process of securing copyright, it created an inducement to manufacture in the United States.

Prior to 1909, as we have mentioned, copyright was secured by depositing copies and registering the work at the time of initial publication. The device to promote American manufacture employed those provisions; the copies that had to be deposited were required to be copies of American manufacture, and the deposit had to be made "on or before the day of publication in this or any foreign country. . ." (26 Stat. 1107). The practical effect was to deny American copyright to works first published abroad. It was conceiv-

able that a British publisher might manufacture two copies of the author's work in this country and deposit them prior to publication, but such an undertaking was hardly likely. Hence if a British author or publisher wanted to obtain United States copyright, American manufacturers could count on his printing an entire edition in the United States and depositing two of the copies so printed.

Thus, for a brief period in the history of our copyright law—a period of eighteen years—the position now taken by the Office would have conformed to the statute. Publication having taken place prior to the deposit of American-made copies, the benefit of American copyright would have been denied to the author. Under the present act, however, the position is utterly out of joint with the statute. The securing of copyright now has nothing to do with the deposit of copies. It flows directly from publication with notice. And deposit and registration can take place any time prior to suit.

This is not to say that in 1909 Congress lost interest in benefiting American printers. On the contrary, it maintained that interest, and developed a new protective mechanism, one that was consonant with the new method of securing copyright but served the same ultimate objectives. Since deposit of copies no longer had anything to do with establishing copyright, it would not matter (for that purpose) whether or not the author had American-made copies to deposit. Hence, in place of the now-anachronistic device of tying American manufacture to the copyright-securing process, Congress made two provisions: (a) it enacted a new manufacturing clause, § 16; (b) it shifted the requirement that the copies deposited be of American manufacture to § 13 (where it would have no effect on obtaining copyright but would be a precondition to suit for infringement).

Congress also continued the ban on importation of foreign-made copies, in § 107.*

Whatever other ambiguities the section may contain, it is plain that § 16 does not purport to form any part of the copyright-securing process. Nor, we submit, does it require a subsequent forfeiture, so long as every copy offered for sale in the United States is manufactured in the United States.** From the beginning, Congress made it clear that the manufacturing clause was directed only to preserving the American market for American printers, and the Congressional purpose has never changed. The Senate report on the 1886 bill that eventually became the Act of 1891 stated:

---

*The ad interim provisions first came into the law when the 1891 statutory scheme was in effect; their aim was to provide some relief from the necessity of printing an American edition before the work could be published in its homeland (if the opportunity to achieve American copyright under the Act of 1891 was not to be lost). (Act of 1904, 33 Stat. 4; Act of 1905, 33 Stat. 1000.) In 1906 the major overhauling of the copyright law that was to produce the Act of 1909 began. Since the Act of 1905 referred only to works written in foreign languages, British authors asked that they too be given relief (H. Rept. No. 2222, 60th Cong. 2d Sess. (1909)). Congress obliged them with the present § 22, but by the time the provision became law in 1909, the copyright-securing system was entirely different from what it had been when the British authors made their request. Despite the fact that the provision was directed to the British authors' problem, its language was broad enough to take in the then-extraordinary situation of an American author publishing abroad. Much later, with the adoption of the Universal Copyright Convention, § 22 became virtually a dead letter for British authors. Its impact now is almost entirely upon American authors—a consequence that would surely have startled the Congress that enacted the provision. To go further, and construe the section as an occasion for deprivation of American rights, would have seemed to that Congress preposterous. We refer to the committee report cited above and to the other Congressional documents that appear below.

**There is now an exception for fifteen hundred copies of foreign manufacture, which may be imported if the author has chosen to proceed via the ad interim provisions.

> "... The foreign author cannot complain, because we give him protection in our market conditioned only that he publish here. The American artisan will be insured *only that which he now possesses*, the labor put upon the publication of foreign books. ..." (S. Rept. No. 1188, 49th Cong., 1st Sess. (1886) p. IV. (Emphasis supplied.)

The American artisan, of course, had not been doing the printing of books that had been published abroad for sale abroad.

During the committee hearings, James Welsh, representing the Typographical Union, was questioned by the chairman:

> "The Chairman: . . . that you are in favor of international copyright, *provided all books of foreign authors published in this country* copyrighted here, shall be published in American houses?
>
> Mr. Welsh: Yes, under the copyright law; that they shall have permission to publish foreign books by coming here and taking out an international copyright, and having their work done on this continent." (Hearings before the Committee on Patents, 49th Cong., 1st Sess. (1886) p. 5. (Emphasis supplied.)

Congress was also concerned about the detriment to American authors and publishers caused by the sale of foreign works in the United States at prices cheaper than those of American books. But here, also, it was only the American market that Congress had in view. At the same hearings, the publisher Henry Holt, after stating the problem, said

> "It follows, then, that an American author, to compete with the cheap foreign reprints must . . . publish at a cheap price himself . . ." (Id., p. 12.)

Senator Platt, one of the sponsors of the 1891 legislation, made the purpose plain on the floor of the Senate:

> "First, however, I will say a word about the clause in our copyright law as proposed by the bill which

> favors the persons who produce books in this country, the men who set the type and perform the labor. I see no injustice whatever—on the other hand, I see great justice—in confining to this country the production of works *which are to be sold in this country. . . .*" (22 Cong. Rec. 2604.) (Emphasis supplied.)

And:

> "We simply make an equitable arrangement that *if a foreign work is to be circulated here,* it is to be printed and bound here." (22 Cong. Rec. 2605.) (Emphasis supplied.)

In these circumstances, subsequent legislative materials may have some slight value in confirming what the actual legislative history (which precedes enactment) already appears to demonstrate. Senate Report No. 375, 81st Cong., 1st Sess. (1949) p. 4, repeating in substance House Report No. 238 (to accompany H.R. 2285), stated: ". . . the repeal of the manufacturing clause would result in the flooding of *the American market* with the products of cheap foreign labor." (Emphasis supplied.) The settled view of the matter is expressed in a letter from the Secretary of State to the Chairman of the Senate Committee on the Judiciary, incorporated in the same Report:

> ". . . the various provisions of title 17 described above are clearly designed to preclude any book in the English language from having copyright protection in the United States unless, with a few exceptions, every copy *sold here* is manufactured in the United States." (Emphasis supplied.)

Moreover, the House Committee Report on the copyright legislation currently before Congress states:

> "The basic purpose of section 601, *like that of the present manufacturing clause,* is to induce the manufacture of an edition in the United States *if more than a certain limited number of copies are to be distributed in this country. . . .*" (H.R. Rept. No. 83, 90th Cong., 1st Sess (1967) p. 135.) (Emphasis supplied.)

The statutory pattern was fundamentally altered by the Act of 1909, but the Congressional purpose that lay behind the manufacturing provision of 1891 also lay behind the quite different manufacturing provision of 1909. As the hearings, reports and debate had made clear, that purpose was to maintain for American printers the trade they had enjoyed in connection with books by foreign authors—that is, the work of printing for the American market—and to prevent the flooding of the American market with books of foreign manufacture. Congress was seeking to preserve, and if possible, to enlarge, the American market for American printers. Congress was not seeking to create a monopoly in overseas markets for our printers. It was altogether outside the contemplation of Congress that it should use the occasion to invent a new business of printing for overseas markets, and that it should establish the new business by imposing burdens on American authors. Yet it is this unlikely, and, we submit, non-existent, legislative intent that must be posited if the Copyright Office thesis is to be accepted.

The Office contention—that the market for which the manufacture is done is irrelevant, and that copyright protection turns on whether we are dealing with the first edition or with subsequent editions—bears no relation to (except as it contradicts) these plainly stated Congressional purposes. Nor does the contention permit a coherent construction of the several provisions of the Act. Indeed, the Office has conceded that the regulation which it has applied in this case conflicts with the Act in at least one important instance—a concession which, we submit, amounts to an admission of invalidity. In the course of the litigation below, counsel for the author presented the following situation: There is to be American and British publication of a work by an American author; all copies of the work, both those to be sold in the United States and those to be sold in Great Britain, are manufactured in the United

States; the number required for British distribution is shipped to England; and publication of the work takes place in Great Britain before it takes place in the United States. Counsel for the Office conceded that even though first publication had taken place abroad, and the ad interim procedures were not followed, such a work would receive copyright protection under the Act (assuming, of course, that it contained the proper copyright notice). The Office regulation states the exact contrary.*

As we have indicated, there is no judicial authority (except the decisions below) directly in point. However, the author's position is consistent, and the Office position is inconsistent, with the fundamental view of the Act of 1909 —and specifically of the effect of § 10—taken in *Washingtonian Publishing Co.* v. *Pearson*, 306 U.S. 30, and in *Heim* v. *Universal Pictures Co.*, 154 F.2d 480 (2 Cir.).

The "Legislative History" Offered by the Copyright Office

The arguments made by the Office in the courts below were grounded on what the Office called "legislative history" (apart from some treatises which themselves supply no other authority). But this consists entirely of statements about the presumed meaning of §§ 16, 22 and 23 made long after those sections became law. The Congressional intent that courts consult is, necessarily, the contemporaneous intent of the legislators who enacted the statute. The legislative history of the provisions governing the present

---

* The concession appears in Transcript of Proceedings in the District Court, p. 25, and in Defendant's Brief after Hearing in the District Court, p. 8. It was repeated in the argument before the Court of Appeals.

Printing in the United States for both American and British publication is already taking place in connection with periodicals. The trend is likely to accelerate in view of the widening "technological gap". Technological advances in this country in duplicating and electronic printing techniques have been particularly rapid.

case was complete in 1909. Statements by legislators speaking decades later (such as the Office cites)—even latter-day statements by those who had a hand in the passing of the bill (such as those rejected in certain cases cited below)—are not legislative history in any pertinent sense.

What the Office relies on is nothing more than what individual Congressmen think to be the meaning of provisions already on the books (or, more realistically, what some lawyer on a Congressional staff, reading secondary authorities, thinks they mean). Retrospective comment on existing statutes where there is no re-enactment is not legislative history. It is at best legal opinion. *United States* v. *Wise*, 370 U.S. 405; *United States* v. *Philadelphia National Bank*, 374 U.S. 321; *United States* v. *Price*, 361 U.S. 304; *Waterman Steamship Corp.* v. *United States*, 381 U.S. 252, and cases cited therein.

In the Court of Appeals, the Office replied that the statements on which the Office relies were made in connection with "successful amendatory legislation." The reply would be pertinent if it was one of the amendments itself whose interpretation were in issue, and if the legislative statements on which the Office bases its argument were statements as to the meaning of the amendment. Such was the situation in the two cases cited by the Office: *United States* v. *Zachs*, 375 U.S. 59 and *Flora* v. *United States*, 362 U.S. 145. But the amendments of 1919 and 1949, in connection with which the statements cited by the Office were made, have no relevance. So far as the issue of the present case is concerned, the provisions of the Act of 1909 were left utterly unaffected by the amendments.* The Office's argument simply does not

*Section 10 is exactly the same now as it was in 1909. With respect to § 22, the amendments merely extended the time periods specified, and did not touch the section's applicability. Similarly, the amendment of § 16 merely conferred an additional benefit on authors who choose to employ the ad interim procedures (allowing importation of 1,500 copies) and did not affect the scope or applicability of the manufacturing requirement.

meet the basic reasoning of the cases listed in the preceding paragraph, which is that "... statutes are construed by the courts with reference to the circumstances existing at the time of the passage...." (*United States* v. *Wise,* 370 U.S. 405, 411) and that "[T]he views of a subsequent Congress form a hazardous basis for inferring the intent of an earlier one." (*United States* v. *Price,* 361 U.S. 304, 313.)

The Question Raised by United Dictionary v. Merriam

The material above has to do with the question whether copyright was attained by the 1958 publication abroad. The case also raises the question whether, if it was not attained by that publication, it was nevertheless not lost, and was eventually secured by the 1964 publication in the United States. This question involves an interpretation of *United Dictionary Co.* v. *Merriam Co.,* 208 U.S. 260, in which this Court held that the notice required under the statute then in force was not required on books published and sold abroad. The reasoning of *United Dictionary,* we submit, would apply as well to the requirements of the manufacturing clause. The broad principle the case stands for is that rights will not be deemed forfeited by events or transactions taking place outside the United States unless Congress has manifested an explicit intent that they should be thus forfeited. There is no such explicit expression in the Act.

The Question Whether the Office Interpretation and Regulation is Entitled to Presumptive Weight

The fact that the Office is an administrative agency does not entitle its interpretation of the statute, in the present circumstances, to any consideration beyond that allowed the arguments of an ordinary litigant. The questions is purely one of law, a question as to which the courts are obliged to give no deference to the views of the Copyright Office. With all the respect due to the Register and his

staff, they bring to the present question no more than other good advocates would bring. This situation has nothing in common with those in which the presumption of administrative regularity has been developed. The present case is one for judicial, not administrative, expertise. Cf. *Grove Press* v. *Christenberry,* 275 F.2d 433 (2 Cir.).

The point is not affected by the fact that the particular view of the law the Office espouses finds formal expression in a regulation. Factors that in proper circumstances entitle an administrative regulation to presumptive validity are not present here. There are other aspects of the statute as to which the Office has a more active function, but the securing of copyright is a matter determined entirely by events in which the Office plays no part. *Washingtonian Publishing Co.* v. *Pearson,* 306 U.S. 30. The Act does not in this regard assign the Office "the task of implementing and enforcing the statute" (Davis, *Administrative Law Treatise,* Vol. 1, § 5.11). The Office has no responsibility for granting or withholding copyright.

Nor is there a background in the problems of making a regulatory statute work, or any corpus of technical non-legal knowledge, that would entitle the Office to claim a clearer view of the present legal question than that of any other litigant. This is not the S.E.C. dealing with securities markets, or the C.A.B. with airline routes, or the F.C.C. with broadcasting licenses.

Nor is the position that the Office has embodied in its regulation "a contemporaneous and long-continued construction of the statute . . ." (*Mazer* v. *Stein,* 347 U.S. 201, 213). On the contrary, for half a century after the statute was enacted the interpretation placed upon it by the Office was the contrary of the interpretation the Office now seeks to impose. The current regulation was promulgated in 1956. Until then a claim to copyright such as this author has made would have been registered and a certificate issued (Howell, *The Copyright Law,* 3rd Ed. (1952) pp. 99-100).

The Constitutional Problems

The construction proposed by the Office raises constitutional problems. Putting an unnecessary burden on authors, it negates the purposes expressed in Article I, § 8, Clause 8. Those purposes may, of course, conflict with other permissible acts of Congress, and the advancement of printers' interests may constitutionally justify a diminution of authors' rights. Thus § 16, to the extent that its language and clear evidence of Congressional intent carries it, is not challenged. But there is no justification for expanding it further—as the Office does—to gain a dubious advantage for printers by derogating from the public interest announced in Clause 8. And in fact the Office interpretation does not benefit American printers. On the contrary, its interpretation requires either that the author employ the ad interim procedures, under which 1,500 foreign-made books may be brought in, or that the work be left unprotected, so that pirated editions may be manufactured abroad and freely imported into the United States—in either case a diminution of the business available to American printers. (Section 107, barring importation, applies only "During the existence of the American copyright . . . ") If, on the other hand, the American author secures copyright when he publishes (with notice) abroad, the American printer is indeed benefited: any copies that come onto our market must be American-made.

The present case supplies a concrete example. G. P. Putnam's Sons, on the writers' warranty of copyright, undertook American publication of the work. To preserve the copyright, this edition for the American market had to be (and was) manufactured here. If there were no copyright to protect, Putnam's might have manufactured the books more cheaply abroad—in Italy, or Holland—and then shipped them into this country. In contrast, the books put out by the infringers against whom the author wishes to proceed are made up of an exact page-by-page,

line-by-line duplication of the author's foreign edition—an evident reproduction by photocopy, demonstrating that American printers had no hand in the manufacture of the infringing books. These two aspects of the situation thus illustrate the fact that the Office regulation, while it injures the author, does so only for the sake of the pirate, and gains nothing for—indeed does harm to—the American printer in whose aid the manufacturing clause was enacted.

A second problem arises under Amendment V. The effect of the Office position is to discriminate not only against authors so situated as compared with other American authors, but also against American authors generally as compared with foreign authors. By reason of the Congressional ratification of the Universal Copyright Convention (in § 9 of the Act), a foreign author would, in the same circumstances, have his work protected. Even if such an incredibly xenophilic approach could be attributed to Congress, it would involve a denial of equal protection, and therefore a violation of the due process guaranteed by the Fifth Amendment. Cf. *Schneider* v. *Rusk*, 377 U.S. 163; *Bolling* v. *Sharpe*, 347 U.S. 497. It may be observed, from the excerpts quoted above at pages 18-20, that the manufacturing clause was regarded by the Congress that enacted it as something that would operate against foreigners.

Third, the combination of hardship and complexity that the regulation imposes upon authors amounts to an impairment of free expression and thus violates the guarantees contained in the First Amendment. Cf. *Dombrowski* v. *Pfister*, 380 U.S. 479; *Memoirs* v. *Massachusetts*, 383 U.S. 413.

The Question Whether, Without Regard to the Merits, the Claim Should Be Registered

In addition, apart from whether the author has or has not secured copyright, the case presents the question whether the Office has discretion to deny registration of

the claim to copyright in a matter of this kind. There are situations in which the Office may properly decline to accept deposit and issue a certificate, but they have little in common with the present case. The decisions supporting discretion have to do with the problem, frequently faced by the Office, whether the object or article as to which registration is sought constitutes copyrightable subject matter. Cf. *United States ex rel. Everson* v. *Young*, 26 Wash. L. Rep. 546 (Sup Ct. D.C.); *King Features Syndicate* v. *Bouve*, 748 U.S.P.Q. 237 (D.C.D.C.); *20th Century Fox Film Corp.* v. *Bouve*, 33 F. Supp. 462 (D.C.D.C.), affd. 122 F.2d 51 (D.C. Cir.); *Brown Instrument Co.* v. *Warner*, 161 F.2d 910 (D.C. Cir.); *Bailie* v. *Fisher*, 258 F.2d 425 (D.C. Cir.). To some extent, of course, these situations require an interpretation of the Act, but there is a critical difference of degree. In the cases cited, the question is mainly factual; a discrete portion of the statute is involved, and the problem has to do with its application to varying concrete fact-situations. In the instant case, in contrast, the facts are plain and uncontroverted, while the question of law is complex and involves the core of the statutory structure.*

There are no administrative considerations requiring that an adjudication of the author's substantive rights be preceded by litigation with the Copyright Office over whether a certificate should issue. There are no housekeeping factors, such as those that might lead the Office to refuse deposit of objects difficult to store or handle. There is no enforcement policy at stake here, such as a regulatory agency might be concerned with. The issuance of the certificate can have no final consequence except to insure that

---

* The scope and meaning of cases upholding Office action with respect to registration must be considered in the light of the purpose that grants the authority: "Section [207] provides for the making of rules and regulations and does not confer upon the register any judicial functions." (H. R. Report No. 2222, 60th Cong., 2d Sess. (1909) p. 20.)

the author's rights be determined according to whether he has copyright in his work, and not according to whether the statute of limitations may have run. The issuance of the certificate prejudges no one's rights. It simply permits the question whether the author has a valid copyright to be litigated in the forum in which the Act contemplates it will be litigated—a federal district court.

American authors who come within the scope of a regulation which (to some extent at least) is concededly in conflict with the Act are denied rights enjoyed by their fellow citizens. Perhaps even more remarkable, they are denied these rights in precisely the same circumstances in which the rights are granted to aliens.

It is not as though so bizarre a result were compelled by clear statutory expression. On the contrary, the result below cannot be reached unless the statutory language has engrafted upon it an unexpressed proviso, a silent and arbitrary distinction between first manufacture and all subsequent manufacture. This is not even a situation where, with language less than clear, a discoverable legislative purpose requires an unfortunate harsh result. Here the protectionist policy that Congress sought to further is not served by the Office gloss upon the Act; on the contrary, as we have mentioned, American printers do not gain but rather stand to lose by it. Meanwhile, Congress has attributed to it the astonishing objective of bestowing benefits upon the foreign writers which it would withhold from citizens.

The "exclusive right" that the Constitution gives Congress power to grant to authors is not to be extended beyond the area in which Congress means to grant it. But Congress, in § 10, clearly marked the area in which the right is to be granted; it is to be granted where there is

publication of an original work with the required notice, without regard to whether the publication takes place in the United States or abroad. That has happened here. The rest is a question of forfeiture, and forfeiture is not to be lightly inferred. The Copyright Act has always been construed so as to encourage our writers to produce, by securing them in their copyright and denying to pirates "the fruits of piracy" (See *Ferris* v. *Frohman*, 223 U.S. 422, 437). If this general principle is to be abandoned here—if the grant in § 10 is to be regarded as qualified even though there is no statutory language qualifying it, nor any evidence of a countervailing Congressional policy that would demand its qualification—the step should not be taken without consideration of the matter by this Court.

CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

CHARLES REMBAR,
MORTON E. YOHALEM,
Attorneys for Petitioner.

APPENDIX A

Appendix of Statutes and Regulation

Pertinent sections of the United States Copyright Law, Act of March 4, 1909, c. 320, 35 Stat. 1075, et seq., as incorporated in the Act of July 30, 1947, c. 391, 61 Stat. 652, et seq., Title 17 U.S.C.:

Section 10 (61 Stat. 656): PUBLICATION OF WORK WITH NOTICE.—Any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this title; and such notice shall be affixed to each copy thereof published or offered for sale in the United States by authority of the copyright proprietor, except in the case of books seeking ad interim protection under section 22 of this title.

Section 13 (61 Stat. 656, as amended): DEPOSIT OF COPIES AFTER PUBLICATION; ACTION OR PROCEEDING FOR INFRINGEMENT.—After copyright has been secured by publication of the work with the notice of copyright as provided in section 10 of this title, there shall be promptly deposited in the Copyright Office or in the mail addressed to the Register of Copyrights, Washington, District of Columbia, two complete copies of the best edition thereof then published, or if the work is by an author who is a citizen or subject of a foreign state or nation and has been published in a foreign country, one complete copy of the best edition then published in such foreign country, which copies or copy, if the work be a book or periodical, shall have been produced in accordance with the manufacturing provisions specified in section 16 of this title; * * * No action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this title with re-

spect to the deposit of copies and registration of such work shall have been complied with.

Section 16 (61 Stat. 657, as amended): MECHANICAL WORK TO BE DONE IN UNITED STATES.—Of the printed book or periodical specified in section 5, subsections (a) and (b), of this title, except the original text of a book or periodical of foreign origin in a language or languages other than English, the text of all copies accorded protection under this title, except as below provided, shall be printed from type set within the limits of the United States, either by hand or by the aid of any kind of typesetting machine, or from plates made within the limits of the United States from type set therein, or, if the text be produced by lithographic process, or photoengraving process, then by a process wholly performed within the limits of the United States, and the printing of the text and binding of the said book shall be performed within the limits of the United States; which requirements shall extend also to the illustrations within a book consisting of printed text and illustrations produced by lithographic process, or photoengraving process, and also to separate lithographs or photoengravings, except where in either case the subjects represented are located in a foreign country and illustrate a scientific work or reproduce a work of art: *Provided, however,* That said requirements shall not apply to works in raised characters for the use of the blind, or to books or periodicals of foreign origin in a language or languages other than English, or to works printed or produced in the United States by any other process than those above specified in this section, or to copies of books or periodicals, first published abroad in the English language,

imported into the United States within five years after first publication in a foreign state or nation up to the number of fifteen hundred copies of each such book or periodical if said copies shall contain notice of copyright in accordance with sections 10, 19, and 20 of this title and if ad interim copyright in said work shall have been obtained pursuant to section 22 of this title prior to the importation into the United States of any copy except those permitted by the provisions of section 107 of this title: *Provided further,* That the provisions of this section shall not affect the right of importation under the provisions of section 107 of this title.

Section 22 (61 Stat. 659, as amended): AD INTERIM PROTECTION OF BOOK OR PERIODICAL PUBLISHED ABROAD.—In the case of a book or periodical first published abroad in the English language, the deposit in the Copyright Office, not later than six months after its publication abroad, of one complete copy of the foreign edition, with a request for the reservation of the copyright and a statement of the name and nationality of the author and of the copyright proprietor and of the date of publication of the said book or periodical, shall secure to the author or proprietor an ad interim copyright therein, which shall have all the force and effect given to copyright by this title, and shall endure until the expiration of five years after the date of first publication abroad.

Section 23 (61 Stat. 659, as amended): SAME; EXTENSION TO FULL TERM.—Whenever within the period of such ad interim protection an authorized edition of such books or periodicals shall be published within the United States, in accordance with the manufacturing provisions specified in section 16 of this title, and whenever the provisions of this title as to deposit

of copies, registration, filing of affidavits, and the printing of the copyright notice shall have been duly complied with, the copyright shall be extended to endure in such book or periodical for the term provided in this title.

Section 107 (61 Stat. 663): IMPORTATION, DURING EXISTENCE OF COPYRIGHT, OF PIRATICAL COPIES, OR OF COPIES NOT PRODUCED IN ACCORDANCE WITH SECTION 16 OF THIS TITLE.—During the existence of the American copyright in any book the importation into the United States of any piratical copies thereof or of any copies thereof (although authorized by the author or proprietor) which have not been produced in accordance with the manufacturing provisions specified in section 16 of this title . . . is prohibited. . . .

Section 9 (61 Stat. 655, as amended): AUTHORS OR PROPRIETORS, ENTITLED: ALIENS.—The author or proprietor of any work made the subject of copyright by this title, or his executors, administrators, or assigns, shall have copyright for such work under the conditions and for the terms specified in this title: *Provided, however,* That the copyright secured by this title shall extend to the work of an author or proprietor who is a citizen or subject of a foreign state or nation only under the conditions described in subsections (a), (b), or (c) below:

* * * (b) When the foreign state or nation of which such author or proprietor is a citizen or subject grants, either by treaty, convention, agreement, or law, to citizens of the United States the benefit of copyright on substantially the same basis as to its own citizens, or copyright protection, substantially equal to the protection secured to such foreign author under this title or by treaty; . . .

> * * * (c) When the Universal Copyright Convention, signed at Geneva on September 6, 1952, shall be in force between the United States of America and the foreign state or nation of which such author is a citizen or subject, or in which the work was first published. Any work to which copyright is extended pursuant to this subsection shall be exempt from the following provisions of this title: . . . (3) the provisions of sections 14, 16, 17, and 18; (4) the import prohibitions of section 107, to the extent that they are related to the manufacturing requirements of section 16; . . .
>
> * * * The provisions of this subsection shall not be extended to works of an author who is a citizen of, or domiciled in the United States of America regardless of place of first publication, or to works first published in the United States.

Regulations of the Copyright Office, 37 C. F. R., issued under authority of 17 U. S. C. § 207 (61 Stat. 666):

> § 202.4 *Books (Class A).* * * * (b) *Ad interim registrations.* (1) An American edition of an English-language book or periodical identical in substance to that first published abroad will not be registered unless an ad interim registration is first made.

APPENDIX B

(Opinion of the U. S. Court of Appeals for the District of Columbia)

UNITED STATES COURT OF APPEALS

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 21,152

MASON HOFFENBERG, Appellant

v.

ABRAHAM L. KAMINSTEIN, Register of Copyrights, Appellee

Appeal from the United States District Court for the District of Columbia

---

Decided April 23, 1968

Mr. Charles Rembar, of the bar of the Court of Appeals of New York, *pro hac vice,* by special leave of court, with whom *Mr. Morton E. Yohalem* was on the brief, for appellant.

Mr. Michael W. Werth, Attorney, Department of Justice, with whom *Assistant Attorney General Edwin L. Weisl, Jr., Messrs. Morton Hollander* and *T. Hayward Brown,* Attorneys, Department of Justice, and *Miss Dorothy Schrader,* Attorney, United States Copyright Office, were on the brief, for appellee. *Mr. John C. Eldridge,* Attorney, Department of Justice, also entered an appearance for appellee.

Opinion of the U. S. Court of Appeals for the District of Columbia

Mr. Stanley L. Temko filed a brief on behalf of the Authors League of America, Inc. as *amicus curiae* urging reversal.

Mr. Ben Cohen filed a brief on behalf of Lancer Books, Inc. *as amicus curiae* urging affirmance.

Before WILBUR K. MILLER, *Senior Circuit Judge*, and BURGER and WRIGHT, *Circuit Judges*.

PER CURIAM: Appellant and Terry Southern, both American citizens, are co-authors of the novel "Candy" which was first printed and published in the English language in France in 1958 with the appropriate statutory copyright notice. *See* 17 U.S.C. §§ 19 and 20 (1964). On March 11, 1965, more than six years after first publication of the foreign edition in France, appellant submitted to appellee an application for registration of a claim to ad interim copyright in the foreign edition. On the same date he submitted an application for registration of a claimed copyright in an American edition of "Candy" which was substantially the same text as the French edition. On March 31, 1965, the Copyright Office refused to register either the claimed ad interim copyright for the French edition or the claim to copyright in the American edition, stating as its reason failure to comply with the provisions of Sections 16[1], 22[2] and 23 of the Copyright Code, 17 U.S.C. §§ 16, 22, 23 (1964). On June 25, 1965, appellant filed the present action in the District Court to compel the Register of Copyrights to issue a certificate of registration covering only the 1964 American edition. On cross-motions for summary judgment, the District Court granted the Register's motion, denied appellant's motion, and dismissed the action.

---

[1] Section 16 requires generally that, for an English-language book to be *registered for copyright* in the United States, it must be printed in the United States.

[2] Section 22 requires that the application for ad interim copyright of a foreign edition of an English-language book be made within six months after publication abroad.

Except when the ad interim provisions of Sections 22 and 23 are met, Section 16 of the Copyright Code allows copyright registration of English-language books by United States citizens only where the first publication is printed in the United States. Implementing these provisions of the Copyright Code pursuant to 17 U.S.C. § 207 (1964), in 1956 the Register of Copyrights promulgated the following regulation:

> "*Ad interim registrations.* (1) An American edition of an English-language book or periodical identical in substance to that first published abroad will not be registered unless an ad interim registration is first made." 37 C.F.R. § 202.4(b)(1967).

Since the novel "Candy" was first published and printed[3] abroad in the English language and there is no ad interim registration of that edition, registration of the American edition was properly refused.

A regulation, of course, is presumptively valid and ordinarily should be upheld unless it is inconsistent with the statute. *New York Foreign Freight Forwarders & Brokers, Ass'n* v. *F.M.C.*, 2 Cir., 337 F.2d 289, 295 (1964), *cert. denied*, 380 U.S. 910, 914 (1965). The above regulation is not only not inconsistent with the pertinent sections of the Copyright Code, but in our judgment it accurately reflects the intention of Congress. *Compare United States* v. *Zasove*, 334 U.S. 602, 611 (1948). Even if there were some doubt, we would be required to resolve that doubt in favor of the Register's interpretation. *Udall* v. *Tallman*, 380 U.S. 1, 16 (1965).

Affirmed.

Circuit Judge BURGER concurs in the result.

---

[3] Appellee concedes that, where a foreign edition is printed in the United States, a subsequent American edition may be registered without compliance with the ad interim provisions of 17 U.S.C. §§ 22 and 23.